

Amendment Under 37 C.F.R. § 1.111
Serial No. 10/729,377
SUGHRUE MION, PLLC Ref: Q78891

AMENDMENTS TO THE DRAWINGS

Figures 5a, 5b, 6 and 7 indicating "PRIOR ART".

Attachment: 2 Replacement Sheets

Amendment Under 37 C.F.R. § 1.111
Serial No. 10/729,377
SUGHRUE MION, PLLC Ref: Q78891

REMARKS

Dealing with preliminary matters first, Applicant thanks the Examiner for acknowledging Applicant's claim to priority as well as receipt of the priority document. Also, Applicant thanks the Examiner for considering the references cited in the Information Disclosure Statement concurrently filed with the application, as evidenced by the returned PTO-1449 form.

Claims 1-8 are all the claims pending in the application. Claims 3-8 have been withdrawn from consideration as being drawn to the non-elected invention. Therefore only claims 1 and 2 have been examined in the application.

The Examiner has requested that Figures 5a, 5b, 6 and 7 be labeled "PRIOR ART". Applicant submits herewith two replacements sheets of drawings where Figures 5a, 5b, 6 and 7 have been labeled "PRIOR ART".

Claims 1 and 2 have been rejected under § 102(e) as being anticipated by Kortenbach (U.S. Patent No. 6,627,817). Applicant respectfully traverses this rejection for the following reasons.

The invention recited in claim 1 is directed to a grommet 10 for holding a wire harness 3 which includes a plurality of wires on which an adhesive tape is wound. The wire harness also includes a water-stop portion and a water-stop agent filled in the interstices between the wires.

According to the invention, the grommet includes a first division member 12 which has a convex portion 14 formed by an outer face thereof and a second division member 13 having a concave portion 23 for receiving the water-stop portion of the wire harness. The concave portion has a shape which corresponds to the cross-sectional shape of the wire harness, as shown in

Figure 2B. Importantly, the grommet is designed such that the convex portion 14 of the first division member is pressed toward the second division member by, for example, the lid 33 of the waterproof box 31, as shown in Figure 4. Due to the presence of the convex portion on the outer face of the first division member, the first division member is pressed against the water-stop portion of the wire harness when the convex portion of the first division member is pressed toward the second division member. This feature of the invention is covered by the “wherein” clause in claim 1 and discussed, for example, in the paragraph bridging pages 16 and 17 of the application.

Turning to the rejection, and with reference to Figure 1 of Kortenbach, the Examiner contends that reference numerals 4b and 2b correspond to the claimed first division member and that reference numeral 4a and 2a correspond to the second division member. As can be seen, the outer face of member 4b has a convex shape, as claim 1 requires. However, Applicant respectfully submits that Kortenbach does not teach or suggest the specific wherein clause recited in claim 1 which recites:

wherein an inner face of the first division member is pressed against the water-stop portion of the wire harness when the convex portion of the first division member pressed toward the second division member.

More specifically, there is no teaching or suggestion in the first instance of applying pressure on the convex portion of member 4b/2b, as the Examiner contends. Thus, it follows that the reference likewise fails to disclose that the first division member is pressed against the water-stop portion in response to the pressing of the convex portion of the first division member.

Applicant directs the Examiner's attention to paragraph 3 of the Office Action. There, the Examiner contends that Kortenbach teaches this feature of the invention. Specifically, the Examiner states as follows:

Regarding claim 1, Kortenbach discloses a grommet... wherein an inner face of the first division member (4b, 2b) is pressed against the water-stop portion of the wire harness (50) when the convex portion of the first division member (4b, 2b) is pressed toward the second division member (see figure 1 or column 8 lines 56-61 or column 11 lines 1-11).

However, Figure 1, column 8, and column 11 of Kortenbach do not support the examiner's contention. Figure 1 merely shows that the outside face of connecting section 4b has a convex shape. However, there is absolutely no teaching or suggestion that pressure is applied against this outer face in order to apply pressure to the wires. Column 8, lines 56-61 only discusses the press element 2a. Specifically, this portion of the reference states as follows:

Each press element 2a is provided with an end portion section having a small cross-section in order to additionally exert pressure on the cable bundle to be inserted, whereby the egress of butyl is to be counteracted.

As can be seen, this portion of the reference does not even discuss the element 4b which the Examiner contends corresponds to the claimed first division member.

Finally, the portion at column 11, lines 1-11 is also not relevant. Specifically, this portion merely recites that the two press elements 2a and 2b are combined such that pressure is exerted on the cable bundle. Again, there is no teaching or suggestion that the pressure results from "the convex portion of the first division member [4b, 2b] being pressed toward the second

Amendment Under 37 C.F.R. § 1.111
Serial No. 10/729,377
SUGHRUE MION, PLLC Ref: Q78891

division member” as claim 1 requires. In short, the reference fails to teach or suggest this feature of the invention.

Turning to the rejection of claim 2, claim 2 recites that the inner face of the first division member of the grommet has a flat face. The Examiner contends that elements 9 or 6 in Figure 1a of Kortenbach discloses this feature of the invention. However, although these portions of the reference show a flat surface, neither of these surfaces is pressed against the water-stop portion of the wire harness, as claims 1 and 2 require. More specifically, claim 1 recites that the inner face of the first division member is pressed against the wire-stop portion of the wire harness and claim 2 recites that the inner face has a flat face. It is clear, in fact, that the portion of the member 4b in Kortenbach that presses against the wire bundle has an arcuate shape, and not a flat shape, as claim 2 requires. Thus, Applicant respectfully traverses the rejection of claim 2 as well.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Amendment Under 37 C.F.R. § 1.111
Serial No. 10/729,377
SUGHRUE MION, PLLC Ref: Q78891

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Brian W. Hannon
Registration No. 32,778

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: June 3, 2005